

The remand being entered today was not written  
for publication and is not binding precedent of the Board.

Paper No. 27

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte JAN HENDRIK MENSEN

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Appeal No. 2004-1343  
Application No. 09/374,598<sup>1</sup>

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REMAND TO EXAMINER

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Before HARKCOM, Acting Chief Administrative Patent Judge, WILLIAM F. SMITH and  
NASE, Administrative Patent Judges.

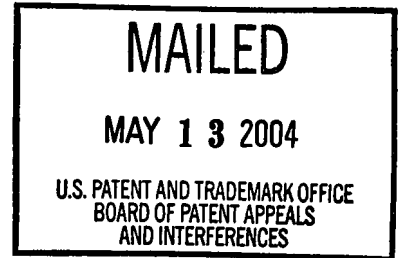
Per curiam.

REMAND TO THE EXAMINER

The above-identified application is being remanded to the examiner for  
appropriate action.

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<sup>1</sup> Application filed August 13, 1999, for reissue of U.S. Patent No. 5,657,600 (Application No. 08/262,505 filed June 20, 1994).



### BACKGROUND

1. A review of the file record indicates that claims 17 to 45 have been rejected under 35 U.S.C. § 251 as attempting to recapture subject matter surrendered in the application to obtain the original patent.

2. A precedential opinion concerning a reissue recapture rejection under 35 U.S.C. § 251 was decided May 29, 2003 in Ex parte Eggert, 67 USPQ2d 1716 (Bd. Pat. App. & Int. 2003). In Eggert, the majority opinion applied the fact-specific analysis set forth in In re Clement, 131 F.3d 1464, 1468-71 45 USPQ2d 1161, 1164-66 (Fed. Cir. 1997), determined that under the facts and circumstances before it, the “surrendered subject matter” was claim 1 of Eggert as that claim existed prior to the post-final rejection amendment that led to the allowance of claim 1 in the original patent, and decided that reissue claims 15-22 of Eggert were not precluded (i.e., barred) by the “recapture rule.” 67 USPQ2d at 1730-33.


### ACTION

We remand this application to the examiner for a determination of whether the rejection under 35 U.S.C. § 251 remains appropriate in view of Ex parte Eggert.

If the examiner determines that the rejection under 35 U.S.C. § 251 remains appropriate, the examiner is authorized to prepare a supplemental examiner's answer specifically addressing the § 251 rejection. In the event that the examiner furnishes a

If the examiner determines that the rejection under 35 U.S.C. § 251 is no longer appropriate, the examiner should withdraw the rejection in an appropriate Office action.

If after action by the examiner in response to this remand there still remains a decision of the examiner being appealed, the application should be promptly returned to the Board of Patent Appeals and Interferences.

  
JEFFREY V. NASE  
Administrative Patent Judge

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